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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,770	04/11/2001	Carlos De La Huerga	250591.90279	2242

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EXAMINER
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MISKA, VIT W

ART UNIT	PAPER NUMBER
2841	

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/832,770

Applicant(s)

DE LA HUERGA, CARLOS

Examiner

Vit W. Miska

Art Unit

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4,5,7-10 and 12-153 is/are pending in the application.
- 4a) Of the above claim(s) 12-14,16,18-21,30-32,34,35,37-106 and 109-153 is/are withdrawn from consideration.
- 5) ☒ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7-10,15,17,22-29,33,36,107 and 108 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1, 2 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Brien (6,150,942). The reference discloses a medication system for performing at least one health safety function including container shown in Fig. 7 identified as "vial" in the specification, and having specifying device RFID TAG (Fig. 7), containing

specifying information ( col. 9, line 47) useable to determine a prescribed dosing regimen (col. 7, lines 19-26), processor 7 (Fig. 6) and associated surface 1.10 (Fig. 1) receiving the specifying information via radio frequency reader 8 when memory device RFID is proximate the surface 1.10 to identify a prescribed dosing regimen described at col. 7, lines 19-26 (determining times of periodic reminders) and performing a health safety function, i.e. prompting the user to take the medication via visual display 15, communication device 15, 19,20 and timing device described at col. 4, line 47 necessary to generate the "correct intervals", the processor, timing device and communication device being linked as shown in the circuit of Fig. 6, the processor uses the specifying information to determine times for taking medication (col. 7, line 23) and causing communication device or visual display 15 to indicate the time.

2. Claims 4, 5, 7-10, 27-29 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Yarin et al (6,294,999). The reference discloses a medication system for performing health safety functions including containers 34 for holding doses of medication, the containers having RF memory device 50 containing specifying information useable to determine a prescribed dosing regimen for the medication (see col. 7, lines 39ff and col. 9, lines 7ff), RF sensors 41 (antennae) defining sensing areas 36 for receiving the specifying information, processor 40 receiving the specifying information to identify a prescribed dosing regimen (col. 9, lines 7-20), communication

device 36 or 36' (Fig. 13), timing device inherently associated with processor 40 (see also col. 10, line 60) and necessary to produce the time alerts for the medication, the processor causing the communication means 36 to indicate predetermined times, col. 10, line 66, horizontal sensor surface 30, container 34 with downward surface 34a and RF tag 50 attached thereto, aligners 32 for distinguishing sensing and non-sensing sections.

3. Claims 4, 5, 7-10, 27-29 and 33 are not accorded the benefit of the filing date of the CIP application 09/185,137, U.S. Patent 6,259,654 for the reasons set forth in the previous Office actions, and, therefore, the Glynn reference is a proper reference under 35U.S.C. 102(e). Applicant has not indicated in his remarks support for the subject matter of these claims in the prior application, only amending claims 1 and 22 in response to the rejection. The changes to claims 1 and 22 to obviate the rejection does not, however, remedy the lack of support for the dependent claims in the prior application. The reasons given previously are repeated here:

4. The subject matter of claims 4, 5, 7-10, 27-29 and 33 do not set forth subject matter which was described in the prior application in a manner to convey to one skilled in the art that applicant had possession of the invention at the time of filing thereof. Specifically, the prior specification or drawings lack reference to a "horizontal sensor surface" of the sensor, or to the containers including "at least one essentially downward

facing surface, the specifying devices are attached to the downward facing surfaces". The statement appearing in the last paragraph of the prior application suggests that "the container could be a tray or cassette that does not include a cap, cover or lid". While the structure now claimed possibly could be included in the implementation of the suggested modification, the description does not convey to one of ordinary skill in the art the suggestion that applicant in fact contemplated this specific construction. It is apparent that the suggested modification could be realized in other ways, for example with the bar code (specifying device) arranged on the side of the containers or vials. Further, if RFID specifying devices were used, these do not require a specific location on the containers, as now claimed. Applicant argues that Figs. 31-34 in the parent patent provide support for the subject matter claimed. However, the embodiment of Figs. 31-34 lacks a "horizontal sensor surface" as claimed, but includes vertical sensor surface 940. The suggestion at col. 32, line 26 of the patent lacks reference to a specific sensor structure or a horizontal surface thereof. Regarding claim 33, no scanning operation is suggested or implied in the prior disclosure. RF circuitry may be of the continuous reception type, without scanning features.

5. Claim 107 rejected under 35 U.S.C. 102(b) as being anticipated by Glynn. The reference discloses an apparatus and method for performing health safety functions

including containers 1,2,4 for holding doses of medication, machine readable and writable memory strips 3,5,7, respectively, containing specifying information ( medicine identity, col. 4, line 38) usable to determine a prescribed dosing regimen (col.4, line 57-58), sensor 13 with sensor area 9 for receiving several specifying devices 3,5,7 receiving the specifying information, sensor 13 linked to ,processor 21 (Fig. 4B), using the information to identify a prescribed dosing regimen (col. 5, line 18), and performing a health safety function (alarm reminders, col. 5, line 29).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glynn (5,774,865) in view of O'Brien. In addition to the elements identified in the preceding paragraph, processor 21 retrieves specifying information from each of the memory devices (col. 5, lines 67). Glynn does not suggest using RF communication for receiving information from the memory devices by the sensor or processor. The preferred embodiment employs bar code labels 3,5,7, and a bar coder reader a sensor 13 for reading labels 3,5,7. However, other alternatives for the bar code type system

are suggested at col. 6, lines 21 and 33, including laser transceivers and magnetic media. Thus, one of ordinary skill in the art would be taught to employ suitable available technology for storing medication data in containers 1,2,4 and corresponding retrieving means 9,13. O'Brien has been identified above and teaches use of radio frequency labels RFID on the bottom surface of medication containers (Fig. 7) and corresponding RFID reader 8 for identifying medication therein. One of ordinary skill in the art having both references would therefore have a suggestion of using this type of radio frequency device for storing and retrieving information from the memory device in place of the bar code reader suggested by Glynn, as an obvious alternative for achieving the benefits of radio communication such as greater reception area and distance, less sensitivity, etc. not associated with optical bar coder readers.

6. Claims 23-26 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glynn and O'Brien, as applied to claim 22, above, in further view of Mucciacciaro (5,239,491). Glynn does not suggest a device for indicating which medication to consume by indicating the containers. Mucciacciaro discloses a medication device with communication devices including separate visual indicators 12 adjacent medication containers indicating the medication to be consumed. It would be obvious for one of ordinary skill in the art having both references, at the time the invention was made, to provide a visual warning indicator in the Glynn system for identifying each container,



as done in the Mucciacciaro device at 12, as an obvious means for prompting the user to take the medication from the correct container.


7. Claim 108 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glynn in view of Mucciacciaro. With respect to the separate sensing areas, Glynn suggests separate sensors positioned under each container (col. 6, line 46). Regarding separate visual indicators for the medication containers, It would be obvious for one of ordinary skill in the art having both references, at the time the invention was made, to provide a visual warning indicator in the Glynn system for identifying each container, as done in the Mucciacciaro device at 12, as an obvious means for prompting the user to take the medication in the correct container.

8. Applicant's arguments have been given careful consideration but have not been found persuasive in view of the additional grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vit W. Miska whose telephone number is 571-272-2108. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, T.C. Patel can be reached on 571-272-2098. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Vit W. Miska  
Primary Examiner  
Art Unit 2841